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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,613	02/02/2004	Roger M. Snow	PA0967.ap.US	2305
75035 7590 06/24/2009 Mark A> Litman and Associates, P.A. York Business Center 3209 w. 76th Street Suite 205 Edina, MN 55435				
EXAMINER				
NGUYEN, BINH AN DUC				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
06/24/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/770,613

Applicant(s)

SNOW, ROGER M.

Examiner

Binh-An D. Nguyen

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

In view of the appeal brief filed on February 6, 2009, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Currently, claims 1-30 are pending in the application. Acknowledgment has been made.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As clarified in *Bilski*, (see *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)), the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. This is called the “machine-or-transformation test”. There are two corollaries to the machine-or-transformation test. First, a mere filed-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle to a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, *for example* by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that it is being transformed, *for example* by identifying the material that is being changed to a different state. (emphasis added)

In keeping with the requirement that a claim should positively recite the particular machine or apparatus to which it is tied, the following operations procedure is set forth:

“Identifying the apparatus” requires that the process claim explicitly recite the particular machine or apparatus, or recite a step that inherently involves the use of a particular machine or apparatus.

The definition of an “inherent tie” is as follows:

The step requires a particular machine or apparatus such that the step cannot be performed mentally or manually in a manner the reasonable accomplishes the intended purpose of the recited invention, as claimed, without the use of a structure.

In this case, claims 1-30 lack the identification of the apparatus or machine that performs the claimed method. Accordingly, the claim is non-statutory under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-15, and 14-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Boylan et al. (5,863,041).

Referring to claim 1, Boylan et al. teaches a method of playing a Pai Gow poker wagering card game comprising: players wagering on a Pai Gow game (1:59-65); dealing seven-card hands from a set of cards to multiple player positions and one dealer position (1:66-2:3); resolving the game of Pai Gow poker (2:3-13). Note that,

Art Unit: 3714

regarding the limitation of players placing either an optional wager against a pay table on a separate poker-type game that uses a best five-card hand from each player's hand, since the wager is optional, it is not necessarily existed in the game method. Further, the recited limitations regarding solving the optional wager are also not necessarily existed in the game method too.

Referring to claim 12, Boylan et al. teaches a method of playing a Pai Gow poker wagering card game comprising: players wagering on a Pai Gow game (1:59-65); dealing seven-card hands to six player positions and one dealer position (1:66-2:3); resolving the game of Pai Gow poker (2:3-13). Note that, regarding the limitation of players placing an optional wager on a separate poker-type game that uses best five-card hands from player cards, since the wager is optional, it is not necessarily existed in the game method. Further, the recited limitations regarding solving the optional (or additional) wager are also not necessarily existed in the game method too.

Referring to claim 14, Boylan et al. teaches the wager against a pay table does not enter the player into an envy hand wagering event (e.g., when the bonus bet is below a predetermined minimum)(4:44-52).

Referring to claims 5 and 15, Boylan et al. teaches the wager against a pay table enters the player into an envy hand wager event (e.g., when the bonus bet is above a predetermined minimum)(4:44-52).

Art Unit: 3714

Referring to claims 6, 11, and 16, Boylan et al. teaches a first level of the wager against a pay table (e.g., bonus bet) enters the player into the wagering event against the pay table and a second and higher level of wager against the pay table (e.g., when the bonus bet is above a predetermined minimum)(4:44-52) enters the player into the wagering event against the pay table and an envy hand poker gaming event (3:17-31; 4:53-5:1).

Referring to claims 7, 8, 17, and 18, Boylan et al. teaches the wager against the pay table is optional (3:3:33-36).

Referring to claims 9 and 19, Boylan et al. teaches a pay table for the best five-card hand for a player requires a rank of at least three-of-a-kind for payment (4:25-52).

Referring to claims 10 and 20, Boylan et al. teaches a pay table for the best 5-Card hand for a player requires a rank of at least a straight for payment (4:25-52).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boylan et al. (5,863,041) in view of Suttle et al. (4,948,134).

Referring to claim 1, Boylan et al. teaches a method of playing a Pai Gow poker wagering card game comprising: (a) Players wagering on a Pai Gow game (1:59-65);

(b) Players placing either an optional or mandatory wager (e.g., bonus bet) against a pay table on a separate poker-type game that uses a best five-card hand from each player's hand (1:65-2:22); (c) dealing seven-card hands from a set of cards to multiple player positions and one dealer position (1:66-2:3); (d) resolving the game of Pai Gow poker (2:3-13); (e) forming best five-card poker hands for at least each player having placed the wager against the pay table (2:14-19); (f) resolving wagers with players who have placed the optional wager when that player's best five-card poker hand equals or exceeds a predetermined rank (2:14-22). Boylan et al. does not explicitly teach the step of (g) providing an additional award to players who have placed the optional wager i) when that player's best five-card poker hand equals or exceeds a predetermined rank and ii) when a best five-card hand for the dealer is equal to or less than a predetermined rank. Suttle et al., however, teaches a method of playing poker which provides an additional award to players who have placed the optional wager (e.g., placing bet after an "ante") when that player's best five-card poker hand equals or exceeds a predetermined rank (2:21-42; 4:4-52) and when a best five-card hand for the dealer is equal to or less than a predetermined rank (e.g., when the dealer's hand is less than Ace-King)(2:32-35; 4:4-12). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the poker rule of Suttle et al. to Boylan et al.'s Pai Gow poker game to provide game player more winning chances thus attract more players to the game and increase casino profit.

Referring to claim 12, Boylan et al. teaches a method of playing a Pai Gow poker wagering card game comprising: (a) Players wagering on a Pai Gow game (1:59-65);

Art Unit: 3714

(b) Players placing an optional wager (e.g., bonus bet) on a separate poker-type game that uses best five-card hands from player cards (1:65-2:22); (c) dealing seven-card hands to six player positions and one dealer position (1:66-2:3); (d) resolving the game of Pai Gow poker (2:3-13); (e) comparing each best five-card poker hand made from player cards against a pay table for predetermined hand ranks (2:14-19); (f) paying players who have both placed the additional wager and provided hands of at least the predetermined rank according to the pay table and rules of the separate poker-type game played with best five-card hands of the players (2:14-22). Boylan et al. does not explicitly teach the step of (g) if a best 5-Card hand for the dealer from the dealer's Pai Gow cards is equal to or less than a predetermined rank, increasing the amount of payment to players from (f). Suttle et al., however, teaches a method of playing poker which provides an award to players who have placed the optional wager (e.g., placing bet after an "ante") when a best 5-Card hand for the dealer from the dealer's Pai Gow cards is equal to or less than a predetermined rank (e.g., when the dealer's hand is less than Ace-King)(2:32-35; 4:4-12). Note that, the limitation of increasing the amount of payment to players as claimed is equivalent to providing additional award as taught by Suttle et al. since they both enhance the award of the players who placed bonus bet. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the poker rule of Suttle et al. to Boylan et al.'s Pai Gow poker game to provide game player more winning chances thus attract more players to the game and increase casino profit.

Referring to claims 2, 3, and 13, Boylan et al. teaches the set of cards comprises a standard fifty-two card deck with at least one joker or the set of cards consists of fifty-three cards, a fifty-two card playing card deck and one joker (3:11-15). Regarding the limitation of there are six player positions to which hands are dealt (claim 2), since up to seven people can play a Pai Gow poker game (with a single deck of 52 card and a joker), a six player positions game to which hands are dealt is considered as a game design choice.

Referring to claims 4 and 14, Boylan et al. teaches the wager against a pay table does not enter the player into an envy hand wagering event (e.g., when the bonus bet is below a predetermined minimum)(4:44-52).

Referring to claims 5 and 15, Boylan et al. teaches the wager against a pay table enters the player into an envy hand wager event (e.g., when the bonus bet is above a predetermined minimum)(4:44-52).

Referring to claims 6, 11, and 16, Boylan et al. teaches a first level of the wager against a pay table (e.g., bonus bet) enters the player into the wagering event against the pay table and a second and higher level of wager against the pay table (e.g., when the bonus bet is above a predetermined minimum)(4:44-52) enters the player into the wagering event against the pay table and an envy hand poker gaming event (3:17-31; 4:53-5:1).

Referring to claims 7, 8, 17, and 18, Boylan et al. teaches the wager against the pay table is optional (3:3:33-36).

Referring to claims 9 and 19, Boylan et al. teaches a pay table for the best five-card hand for a player requires a rank of at least three-of-a-kind for payment (4:25-52).

Referring to claims 10 and 20, Boylan et al. teaches a pay table for the best 5-Card hand for a player requires a rank of at least a straight for payment (4:25-52).

Referring to claims 21 and 22, wherein no fee is charged by the dealer for a favorable resolution of the Pai Gow wager when the wager against the pay table is made and a qualifying wager for an envy hand poker game is made, this is a design choice since it depends on the rules of the house regarding charging a fee to players.

Referring to claims 23-30, wherein the additional award is a multiple of at least 1 times the wager against the pay table (claims 23 and 27); wherein the multiple is fixed (claims 24 and 28); wherein the multiple is variable, depending upon a composition of the dealer's best five card hand (claims 25 and 29); and wherein the sym of an award from step (f) and step (g) is equal to a multiple of the wager from step (b) (claims 26 and 30), these limitations are design choice since setting up different payment odds to the game does not bring unexpected results to the game output.

Response to Arguments

Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

Art Unit: 3714

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Boylan et al. teaches a method of playing a Pai Gow poker wagering card game comprising: (a) Players wagering on a Pai Gow game (1:59-65); (b) Players placing either an optional or mandatory wager (e.g., bonus bet) against a pay table on a separate poker-type game that uses a best five-card hand from each player's hand (1:65-2:22); (c) dealing seven-card hands from a set of cards to multiple player positions and one dealer position (1:66-2:3); (d) resolving the game of Pai Gow poker (2:3-13); (e) forming best five-card poker hands for at least each player having placed the wager against the pay table (2:14-19); (f) resolving wagers with players who have placed the optional wager when that player's best five-card poker hand equals or exceeds a predetermined rank (2:14-22). Suttle et al. further teaches a method of playing poker which provides an additional award to players who have placed the optional wager (e.g., placing bet after an "ante") when that player's best five-card poker hand equals or exceeds a predetermined rank (2:21-42; 4:4-52) and when a best five-card hand for the dealer is equal to or less than a predetermined rank (e.g., when the dealer's hand is less than Ace-King)(2:32-35; 4:4-12). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide the poker rule of Suttle et al. to Boylan et al.'s Pai Gow poker game to provide game player more winning chances thus

attract more players to the game and increase casino profit. Boylan et al. in view of Suttle et al., therefore, made obvious the applicant's claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art
Unit 3714